

U.S. Patent Application Serial No. 09/763,531
Amendment filed October 8, 2004
Reply to OA dated July 13, 2004

REMARKS

Claims 1-24 are currently pending in this application. An amendment is proposed canceling claim 18 without prejudice or disclaimer, and amending claims 17 and 19. Upon entry of this amendment, claims 1-17 and 19-24 will be pending.

Applicant respectfully submits that no new matter has been added. It is believed that this Response is fully responsive to the Office Action dated **July 13, 2004**.

Claims 17-19 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. (Office action paragraph no. 1)

The rejection is overcome by the proposed amendments to the claims.

The Examiner notes that formula (V-1) was deleted from claim 16, but is still recited in claims 17-19. In the proposed amendments, the recitation of formula (V-1) is deleted from claims 17 and 19. Accordingly, the formulas (V-1A) and (V-1B) are deleted from claim 17. In the amendment to claim 19, the recitation that "U¹ is the same as previously defined ..." is also deleted, since this is unnecessary. Claim 18 is canceled without prejudice or disclaimer.

Entry of the amendments and reconsideration of the rejection are respectfully requested.

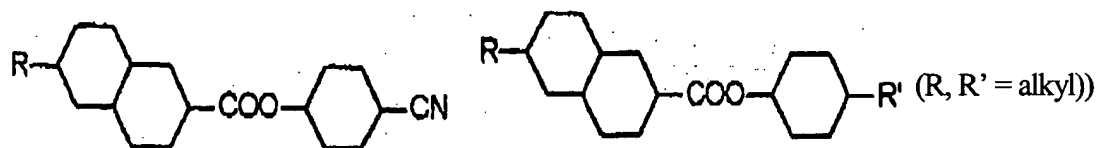
Claims 1-5, 7-9 and 21-22 are rejected under 35 U.S.C. §102(b) as being anticipated by Boller et al. (U.S. Patent No. 4,391,731). (Office action paragraph no. 2)

The rejection of claims 1-5, 7-9 and 21-22 is respectfully traversed, and reconsideration of the rejection is requested.

The Examiner cites formula I in the reference, when R^2 is an ester group of formula II, X is oxygen, B = 1,4-cyclohexyl and R^3 = cyano or straight alkyl chain, as anticipating the claims. The Examiner cites, in particular, column 7, lines 29-58.

Column 7, lines 29-58, of the reference lists 15 specific compounds. These are all 6-alkyl-trans-decalin-2-carboxylic acid esters, with the alcohol portion of the esters being substituted cyclohexyls.

These compounds in the reference (6-alkyl-trans-decalin-2-carboxylic acid trans-4-substituted-1-cyclohexyl esters,



would be consistent with formula (1) in present claim 1 where $m=0$, $n=1$, $R=\text{alkyl}$, $M=\text{COO}$, B is trans-1,4-cyclohexylene, and Z is alkyl or cyano. However, this situation is **excluded by proviso (ii) in claim 1**.

Moreover, even if the cyclohexane ring of these compounds were replaced with a benzene ring, these compounds would also be excluded from the scope of the present invention by the proviso (iii) of claim 1.

Applicant submits that the general disclosure of formula I in the reference, encompassing an enormous number of compounds not within the scope of claim 1, clearly cannot be considered to anticipate claim 1.

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Since claim 1 does not read on any of the compounds cited by the Examiner, Applicant submits that claims 1-5, 7-9, and 21-22 are not anticipated by Boller et al.

Claims 23 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Boller et al. (U.S. Patent No. 4,391,731) above. (Office action paragraph no. 4)

The rejection of claims 23 and 24 is respectfully traversed and reconsideration of the rejection is requested.

The Examiner states that the reference differs from the claims in the recitation of an active matrix or super-twist display device. However, Applicant has argued above that the limitations of base claim 1, from which claims 23 and 24 are ultimately dependent, are **not** disclosed by the reference. Applicant therefore submits that claims 23 and 24 are non-obvious over Boller et al.

Claims 6, 10-13 are objected as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 14-16 and 20 are allowed. (Office action paragraphs no. 5-6)

Since Applicant has argued above against the rejection of base claim 1, Applicant has not amended claims 6 and 10-13 to be in independent form.

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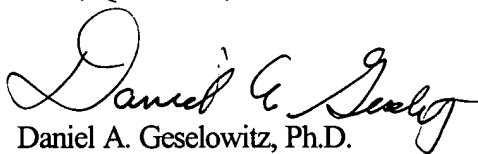
In view of the aforementioned amendments and accompanying remarks, the claims, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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